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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/552,272 | 04/19/2000 | Li Fang | 913.6600CIP | 3198 |

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IP GROUP OF DLA PIPER RUDNICK GRAY CARY US LLP
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PHILADELPHIA, PA 19103

EXAMINER

EPPS FORD, JANET L

| | |
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| ART UNIT | PAPER NUMBER |
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1633

DATE MAILED: 04/04/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

09/552,272

Applicant(s)

FANG ET AL.

Examiner

Janet L. Epps-Ford

Art Unit

1633

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 13 March 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☐ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☒ Applicant's reply has overcome the following rejection(s): See Continuation Sheet.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: 1,5,6,10,14-18,20,21,23,24,26-36 and 38-56.
Claim(s) objected to: _____.
Claim(s) rejected: 19,22,25,37 and 57.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____
13. ☐ Other: _____.


JANET L. EPPS-FORD, PH.D.
PRIMARY EXAMINER

DETAILED ACTION

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
2. Claims 1, 5-6, 10, and 14-57 are presently pending.

Response to Arguments

3. Those rejections set forth in the prior Office Action that are not repeated in the instant Office Action have been withdrawn in response to Applicant's amendment and/or arguments.

Claim Rejections - 35 USC § 112

4. Claims 19, 22, 25, 37, and 57 remain rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention, for the reasons of record set forth in the Official Action mailed 11-19-02.

Applicant's arguments filed 3-13-06 have been fully considered but they are not persuasive. Applicants traversed the instant rejection by way of amendment, and on the following grounds: "[F]or the reasons set forth in the Applicants' response of September 21, 2005 and earlier responses, the Applicants respectfully submit that the claimed recitation is fully supported by the written description. Nonetheless, Claims 16, 19, 28, 38, 39, 40 and 50 have been amended in order to expedite allowance of the application. Specifically, the recitation of a fragment that will hybridize under high stringency

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conditions has been deleted. According to the claim, the first nucleic acid fragment includes SEQ ID NO: 48, SEQ ID NO: 49 or SEQ ID NO: 50."

However, contrary to Applicant's assertions, it remains that claims 19, 22, 25, 37, and 57 still recite the language that "a fragment that will hybridize under high stringency conditions." The hybridization language has not been deleted as suggested by Applicants. Therefore as stated in the prior Office Action, since the claims are to be given the broadest reasonable interpretation consistent with the specification (See MPEP § 2111 - § 2116.01), the claims can also be interpreted as reading on a genus of nucleic acid fragments, of undefined length and origin that will hybridize under high stringency conditions *to a reference nucleic acid, of undefined length and origin* that comprises a region that is precisely complementary to nucleotides 1-11, 1-25, or 56-117 of SEQ ID NO: 55. The scope of nucleic acid fragments that are encompassed by the claims are not limited to those sequences that will hybridize under high stringency conditions to a reference nucleic acid that is precisely complementary to the full length sequence of nucleotides 1-11, 1-25 or 56-117 of SEQ ID NO: 55, wherein said reference nucleic acid sequence is of identical length to 1-11, 1-25, or 56-117 of SEQ ID NO: 55 to which it is precisely complementary. Therefore the scope of nucleic acids encompassed by the instant claims includes those fragments that will hybridize to other regions of the reference nucleic acid that are not precisely complementary to nucleotides 1-11, 1-25 or 56-117 of SEQ ID NO: 55, wherein the structure is completely undefined. As stated previously, the genus of nucleic acids encompassed by the instant claims is very broad, since the claims encompass "a fragment" of unknown length,

structure and source, and there is no clear correlation between the claimed structures and the recited function. Apart from further experimentation, the skilled artisan would not be able to predict the structures of the full scope of nucleic acid molecules encompassed by the instant claims.

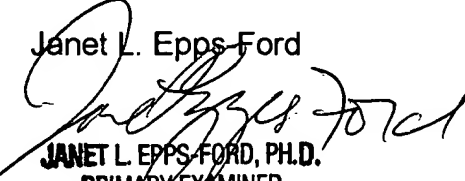
Conclusion

5. 19, 22, 25, 37, and 57 remain rejected.
6. Claims 1, 5-6, 10, and 14-18, 20-21, 23-24, 26-36, and 38-56 are free of the prior art searched, and are allowable.
7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Janet L. Epps-Ford whose telephone number is 571-272-0757. The examiner can normally be reached on M-F, 9:30 AM through 6:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dave T. Nguyen can be reached on 517-272-0731. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Patent applicants with problems or questions regarding electronic images that can be viewed in the Patent Application Information Retrieval system (PAIR) can now contact the USPTO's Patent Electronic Business Center (Patent EBC) for assistance. Representatives are available to answer your questions daily from 6 am to midnight (EST). The toll free number is (866) 217-9197. When calling please have your application serial or patent number, the type of document you are having an image problem with, the number of pages and the specific nature of the problem. The Patent Electronic Business Center will notify applicants of the resolution of the problem within 5-7 business days. Applicants can also check PAIR to confirm that the problem has been corrected. The USPTO's Patent Electronic Business Center is a complete service center supporting all patent business on the Internet. The USPTO's PAIR system provides Internet-based access to patent application status and history information. It also enables applicants to view the scanned images of their own application file folder(s) as well as general patent information available to the public.

For all other customer support, please call the USPTO Call Center (UCC) at 800-786-9199.

Janet L. Epps Ford

JANET L. EPPS-FORD, PH.D.
PRIMARY EXAMINER

Continuation of 5. Applicant's reply has overcome the following rejection(s): The rejection of claims 16-18, 20-21, 23-24, 26-36, and 38-56 under 35 USC 112, 1st paragraph is withdrawn in response to Applicant's amendment and arguments.

Continuation of 11. does NOT place the application in condition for allowance because: Applicant's response has not overcome the rejection of claims 19, 22, 25, 37 and 57 for the reasons of record. See the attached response to Applicant's arguments.